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In re Application of : SEP 16 2004
Henry J. Riblet :
Application No. 09/955,467 :
Filed: September 17, 2001 : ON PETITION
Title of Invention: :
BRACKET ASSEMBLY LOCK :

OFFICE OF PETITIONS

This is a decision on the Petition to Revival Unavoidably Abandoned Application, filed July 30, 2004, to revive the above-identified application.

The petition is dismissed.

Any further petition to revive the above-identified application (under 37 CFR 1.137(a)), must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under 37 CFR 1.137", and be addressed to Petitions Attorney Derek L. Woods. This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed September 5, 2003. The Office action set a three (3) month period for reply.

Applicant filed a response to the Office action on December 4, 2003; however, the response failed to place the application in condition for allowance. Applicant was so notified in an Advisory Action mailed January 27, 2004.

Accordingly, the application became abandoned for failure to timely and properly reply to the final Office action that was mailed on September 5, 2003, on December 6, 2003. A Notice of Abandonment was mailed on April 22, 2004.

Applicant's Response

In response to the Notice, Applicant files the instant petition wherein Applicant avers that the unavoidable abandonment of the application because Applicant received no word from the patent lawyer between January 27, 2004 and May 17, 2004.

Requirements for a Grantable Petition Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks items (1) and (3) as set forth above.

Applicant is initially advised that the Advisory Action did not extend the deadline for filing a complete and proper reply to the final Office action, which was mailed on September 5, 2003. The Advisory Action simply informed Applicant that his response to the final Office action, that Applicant filed on December 4, 2003, was not a complete and proper response to the September 5, 2003 final Office action and therefore failed to place the application in condition for allowance. The application became abandoned because Applicant failed to timely and properly reply to the final Office action, mailed September 5, 2003. The Advisory Action advised Applicant that the time period for a reply to the September 5, 2003 Office action continued to run from the mail date of the September 5, 2003 final rejection. The final rejection informed applicant that he had three (3) months to reply, and that extensions of time were available. Applicant could have bought three (3) additional months within which to reply; thereafter, the application became \

abandoned - on the day after the expiration of the three (3) month period for filing a reply. Applicant has filed the instant petition, but has not filed a reply to the September 5, 2003 Office action that would place the application in condition for allowance. Accordingly, Applicant has failed to satisfy item (1) above.

Further to this Applicant is directed to the MPEP, section 711.02, which reads:

37 CFR 1.135(a) specifies that an application becomes abandoned if applicant 'fails to reply' to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e. failure to file a 'complete and proper reply, as the condition of the case may require' within the statutory period (37 CFR 1.135(b)).

This section clearly explains that abandonment occurs when petitioner fails to timely and properly reply to the outstanding Office action.

Petitioner is also directed to 37 CFR 1.135(b), Abandonment For Failure to Reply Within Time Period, which reads:

Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

This section is further clarified in the Manual of Patent Examining Procedure ("MPEP"), which provides

[f]or example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not \square unavoidable \square when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.

This section explains that a delay is not unavoidable when the applicant-petitioner is awaiting an action from the examiner.

In other words, when Applicant filed the response to the final Office action, it was Applicant's responsibility to file a complete and proper reply as the application required. The Advisory Action was a courtesy mailed to Applicant which attempted to notify Applicant that the filed response failed to comply with what was required. The time to file a complete and proper reply continued to run from the mailing of the final Office action on September 5, 2003. Petitioner was not given a new period to reply with the mailing of the Advisory Action.

In addition, Applicant has failed to satisfy item (3) above. The following is the law that governs revival of an application abandoned unavoidably:

Applicable Law

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullah, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

As to Applicant's lack of knowledge of the patent rules, Applicant is advised that nonawareness of the content of, or a

misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay. Moreover, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also *In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (*while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction*) (Emphasis supplied). Accordingly, Applicant may not rely upon his lack of knowledge of patent law to support an unavoidable delay.

Applicant is further advised that it is his responsibility to provide a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. Here, the period of the delay is from the due date for the reply, December 5, 2003, until the filing of a grantable petition, which, at a minimum, runs to the filing of this petition. This petition is not grantable and, as such, the period of delay continues to run. Applicant attempts to account for the period between January 27, 2004 and May 17, 2004; however, Applicant must account for the period between December 5, 2003 and the filing of a grantable petition.

Conclusion

Applicant has failed to address both items (1) and (3). Applicant must file a complete and proper reply to the final Office action, and Applicant must account for the entire delay in responding to the September 5, 2003 Office action.

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently \$665.00.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

It is also noted that the correspondence address on the petition differs from the correspondence address of record. While a courtesy copy of this Decision is being mailed to the person filing the instant petition, future correspondence will be mailed to the correspondence address of record until such time that a Power of Attorney and/or change of correspondence address is filed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: 2201 South Clark Place
 Customer Window
 Crystal Plaza Two, Lobby Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.


Derek L. Woods
Petitions Attorney
Office of Petitions

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